

REMARKS/ARGUMENTS

In the Restriction Requirement dated August 21, 2009, the Examiner delineated the following inventions as being patentably distinct:

Group I: Claims 1-32, drawn to a diamond wafer assembly; and

Group II: Claims 33-48, drawn to a method of producing a single crystal diamond substrate.

Applicants provisionally elect with traverse the invention of Group I (Claims 1-32) drawn to a diamond wafer assembly.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The claims of Groups I, II, and III are integrally related as product, method of making and the use of thereof. The Examiner has failed to show other than allege that the claims of Group II have other uses besides that shown by the instant invention or can be made by other methods. There is a commonality that exists between the groups. It is a technical relationship that defines the contribution which each of the groups taken as a whole makes over the prior art. Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Final product, method of making and the use thereof are considered related inventions under 37 C.F.R. § 1.475, and unity of invention between the groups exists.

Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact the International Search Authority has search all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to . . . (3) a product, process for the manufacture of said product and/or method of use.”

Applicants request that if the invention of Group I is found allowable, withdrawn Groups II and III which include the limitations of the allowable claims be rejoined.

Divisional applications filed thereafter containing the non-elected invention should not be subject to double patenting ground of rejection (35 U.S.C. § 121, In re Joyce (Comr. Pats. 1957) 115 USPQ 412).

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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